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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,485	08/27/2001	Chikako Kariya	1484.1007	2872
21171	7590	03/15/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,485	KARIYA, CHIKAKO
Examiner	Art Unit	
CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 November 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8,10-18,20-27,29-37,39-46 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8,10-18,20-27,29-37,39-46 and 48-56 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 11/15/2004.

This action is made Final.

2. In the amendment, claims 9, 19, 28, 38, 47, and 57 have been canceled. Claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 are pending in the case. Claims 1, 11, 20, 30, 39, and 49, are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 1/16/2002 has been entered, and considered by the examiner.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 200-373784 filed in Japan on 12/8/2000, which papers have been placed of record in the file.

Drawings

5. The drawings filed on 8/27/2001 have been approved by the examiner.

Claim Objections

6. Appropriate amendment was made to claim 1. Therefore, the objection to claims 1-10 has been withdrawn.

Claim Rejections - 35 USC § 112

7. Appropriate amendments were made to claims 16, 35, and 54. Therefore, the rejections have been withdrawn.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 remain rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al, hereinafter Moody (Pat.# 5,890,177, 3/30/1999).

Regarding independent claim 1, Moody discloses comparing an original document and an edited copy of the same document to determine similarities, and differences, if any, among the

documents, which are emailed among an author and editors—*the documents are electronic mail documents* (col.7, lines 21-67, col.4, lines 34-51).

Furthermore, Moody discloses the comparison of similarities and differences—*relevance information*— between paragraphs of two documents emailed between the author, and editors—*exchange history of the electronic mail documents*— such as an original document, and an edited copy of the original document (which was edited, after the original document was created—*timewise latest document*—based on a heritage —*header*— containing a timestamp—*timewise order*— indicating when the document was created or edited) (col.10, lines 15-35, col.4, lines 34-51).

Regarding claim 2, which depends on claim 1, Moody discloses the comparison of similarities or differences between paragraphs of two documents, based on a creator ID —*header information* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 3, which depends on claim 2, Moody discloses presenting or displaying the documents and their similarities and differences—*relevance information*— in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*outputs the relevance information in a timewise order*— (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 4, which depends on claim 1, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as

redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 5, which depends on claim 4, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 6, which depends on claim 5, Moody discloses presenting or displaying the documents—*document selected at the locator*— and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 7, which depends on claim 2, Moody discloses the comparison of differences—*branched state*— between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state*— are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 8, which depends on claim 5, Moody discloses the comparison of differences—*branched state*— between paragraphs of two documents, based on a creator ID —

header information according to a uniqueness rule in each of the documents. The differences or edits—*detected branched state*— are presented in a visible way using techniques such as redlining , in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 10, which depends on claim 1, discloses returning edited copies of the original document back to the author using email—*the documents located by the locator are subjected to a return mail processing.* The documents are arranged in a hierarchical tree-like order in a markup document (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding independent claim 11, Moody discloses comparing an original document and an edited copy of the same document to determine differences, if any, among the documents, which are emailed between an author and editors—*the documents are electronic mail documents* (col.7, lines 21-67, col.4, lines 34-51).

Moreover, Moody discloses a word processing software for deleting duplicate paragraphs of the documents, and producing a final document (col.7, lines 1-20). In other words, the software is used to go through all the paragraphs and removes the duplicate paragraphs, and creates a final document without the duplicate paragraphs—*parsing overlapped portion of information and for merging the documents with the overlapped portion eliminated.* A comparison of similarities and differences—*relevance information*— between paragraphs of two documents emailed among the author, and editors—*exchange history of the electronic mail documents*—is determined by the software.

Regarding claim 12, which depends on claim 11, Moody discloses the merging of the final document by using a document containing various editions of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs—*merges the documents according to an order of the related documents* (col.6, lines 56-67, fig.3).

Regarding claim 13, which depends on claim 11, Moody discloses the comparison of paragraphs based on an on heritage containing an ID of the editor who made the edits to the corresponding document—*detect relevance among the documents based on the header information* or editor initials (col.10, lines 15-35).

Regarding claim 14, which depends on claim 13, Moody discloses the comparison of paragraphs of two documents, based on a heritage—*header*-- containing a timestamp—*timewise order*-- indicating when the document was created or edited—*detect relevance among the documents based on the header information* or editor initials. The differences or edits are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*timewise order* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 15, which depends on claim 11, Moody discloses the display of a markup document containing various editions—*relevance documents*-- of the original document

organized in a tree order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-67, fig.3).

Regarding claim 16, which depends on claim 15, Moody discloses using the markup document containing various editions, and which is displayed in a tree order, for producing, and displaying a final document creating by merging several of the edited documents—*relevance documents*— of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-col.7, line 20, fig.3).

Regarding claim 17, which depends on claim 13, Moody discloses the comparison of differences—*branched state*— between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state*— are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 18, which depends on claim 15, Moody discloses the comparison of differences—*branched state*— between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state*— are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Claims 20-37 are directed towards a computer program product on a computer-readable medium for performing the steps found in claims 1-18 respectively, and therefore are similarly rejected.

Claims 39-46, 48-56 are directed towards a method for implementing the device found in claims 1-8, and 10-18, respectively, and therefore are similarly rejected.

Response to Arguments

10. Applicant's arguments filed 11/15/04 fully considered but they are not persuasive. Regarding the amended claims, Applicant submits that "Moody et al. at least fails to disclose the presently claimed documents being electronic mail documents and/or the claimed relevance information being detected by the detector being an "exchange history of the electronic mail documents.... the emailed edited documents would appear to only be attachments to their respective emails. The attachments are not electronic mail documents. In addition, Moody et al. would appear to remove the email attachments, convert each document into the proper format, and then evaluate the edits within each document " (pages 12-13). The Examiner disagrees, because Moody discloses comparing an original document and an edited copy of the same document to determine similarities, and differences, if any, among the documents, which are emailed among an author and editors—*the documents are electronic mail documents* (col.7, lines 21-67, col.4, lines 34-51). In other words, the documents are edited and emailed to the author from the editors. There is no indication that these documents are email attachments in Moody.

Even if the documents were email attachments, they would be part of the email—email documents.

Furthermore, Moody discloses the comparison of similarities and differences—*relevance information*-- between paragraphs of two documents emailed between the author, and editors—*exchange history of the electronic mail documents*-- such as an original document, and an edited copy of the original document (which was edited, after the original document was created—*timewise latest document*--based on a heritage —*header*-- containing a timestamp—*timewise order*-- indicating when the document was created or edited) (col.10, lines 15-35, col.4, lines 34-51).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

3/9/05